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OFFICE OF PETITIONS

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| In re Application of | : | |
| Alfonta, et al. | : | |
| Application No. 10/575,991 | : | DECISION |
| Filed: 13 March, 2006 | : | |
| Attorney Docket No: 54-000711US | : | |

This is a revised decision on the petition filed on 5 October, 2010, considered as a petition under 37 C.F.R. §1.181 (no fee) requesting withdrawal of the holding of abandonment in the above-identified application, alternatively pleaded as a "contingent" petition pursuant to 37 C.F.R. §1.137(b) for revival of an application abandoned due to unintentional delay.

The petition pursuant to 37 C.F.R. §1.181 is **GRANTED**; and the petition pursuant to 37 C.F.R. §1.137(b) is **DISMISSED**; the decision of 3 January, 2011 is withdrawn.

As to the Request to Withdraw
the Holding of Abandonment

A Petitioner's attentions always are directed to the Commentary at MPEP §711.03(c)(I) for guidance as to the proper showing requirements for relief under 37 C.F.R. §1.181.

As to the Allegations
of Unintentional Delay

The requirements of a grantable petition pursuant to 37 C.F.R. §1.137(b) are the petition and fee therefor, a reply, a proper statement and/or showing of unintentional delay under the regulation, and, where applicable, a terminal disclaimer and fee

A Petitioner's attentions always are directed to the guidance in the Commentary at MPEP §711.03(c)(II).

BACKGROUND

The record reflects as follows:

Petitioner failed to reply timely and properly to the non-final Office action mailed on 13 November, 2009, with reply due absent extension of time on or before 13 January, 2010.

The application went abandoned by operation of law after midnight 13 January, 2010.

The Office mailed the Notice of Abandonment on 1 June, 2010.

On 21 June, 2010, Petitioner Gary Baker (Reg. No. 41,595) filed, *inter alia*, a petition pursuant to 37 C.F.R. §1.181 and averred, *inter alia*, non-receipt of the Office action but failed to make the statements and documentary showing as required and expressly set forth in the guidance in the Commentary at MPEP §711.03(c)(I)—including the required copy of the application docket sheet, Petitioner's office due date calendar for the due date of the reply. Petitioner failed to make the statements, *inter alia*:

- non-receipt at the correspondence address of record;
- search (of the file, docket and calendar) and non-discovery with description of the docketing system;
- sufficient reliability with a showing/statement that the due date calendar is that for Petitioner's office/firm, all to ensure, *inter alia*, that the Office action herein had not been misfiled.

Further, Petitioner stated that he was including a "contingent" petition pursuant to 37 C.F.R. §1.137(b) and averred inclusion of fees, but the record is silent as to any indication that fees were paid and there was no deposit account or other authorization provided for fees. Petitioner included a reply in the form of an amendment and made a statement of unintentional delay.

The petitions were dismissed on 17 August, 2010.

On 5 October, 2010, Petitioner re-advanced the petition pursuant to 37 C.F.R. §1.181 and averred, *inter alia*, non-receipt of the Office action; while Petitioner did not submit a copy of his docket sheet to accompany his due date calendar, the Office has determined to so construe Petitioner's submissions, and is construing his statements to have complied with the guidance in the Commentary at MPEP §711.03(c)(I)

Further, Petitioner stated that he was including a “contingent” petition pursuant to 37 C.F.R. §1.137(b) with fee and reply in the form of an amendment and made a statement of unintentional delay.

The fee for this petition is refunded *via* deposit account. Should Petitioner later find that the fee was not refunded, Petitioner should direct a request to the Finance Branch with a copy of this decision.

With regard to Petitioner’s request to withdraw the holding of abandonment pursuant to 37 C.F.R. §1.181, the guidance in the Commentary at MPEP §711.03(c)(I) provides in pertinent part as to non-receipt:

The showing required to establish nonreceipt of an Office communication must include a statement from the practitioner describing the system used for recording an Office action received at the correspondence address of record with the USPTO. The statement should establish that the docketing system is sufficiently reliable. It is expected that the record would include, but not be limited to, the application number, attorney docket number, the mail date of the Office action and the due date for the response.

Practitioner must state that the Office action was not received at the correspondence address of record, and that a search of the practitioner's record(s), including any file jacket or the equivalent, and the application contents, indicates that the Office action was not received. A copy of the record(s) used by the practitioner where the non-received Office action would have been entered had it been received is required.

A copy of the practitioner's record(s) required to show non-receipt of the Office action should include the master docket for the firm. That is, if a three month period for reply was set in the nonreceived Office action, a copy of the master docket report showing all replies docketed for a date three months from the mail date of the nonreceived Office action must be submitted as documentary proof of nonreceipt of the Office action. If no such master docket exists, the practitioner should so state and provide other evidence such as, but not limited to, the following: the application file jacket; incoming mail log; calendar; reminder system; or the individual docket record for the application in question.¹

The requirements for a petition pursuant to 37 C.F.R. §1.137(b) have been set forth above and below.

¹ See: MPEP §711.03(c)(I)(A).

Out of an abundance of caution, Petitioners always are reminded that:

- the filing of a petition pursuant to 37 C.F.R. §1.181 does not toll any periods that may be running any action by the Office and a petition seeking relief under the regulation must be filed within two (2) months of the act complained of (*see*: 37 C.F.R. §1.181(f)); and
- those registered to practice and all others who make representations before the Office **must** inquire into the underlying facts of representations made to the Office and support averments with the appropriate documentation—since all owe to the Office the continuing duty to inquire and disclose.²

The availability of applications and application papers online to applicants/practitioners who diligently associate their Customer Number with the respective application(s) now provides an applicant/practitioner on-demand information as to events/transactions in an application.

STATUTES, REGULATIONS

Congress has authorized the Commissioner to "revive an application if the delay is shown to the satisfaction of the Commissioner to have been "unavoidable." 35 U.S.C. §133 (1994).

The regulations at 37 C.F.R. §1.137(a) and (b) set forth the requirements for a Petitioner to revive a previously unavoidably or unintentionally, respectively, abandoned application.^{3, 4}

Allegations as to the Request to Withdraw the Holding of Abandonment

The guidance in the Commentary at MPEP §711.03(c)(I) specifies the showing required and how it is to be made and supported.

² See supplement of 17 June, 1999. The Patent and Trademark Office is relying on Petitioner's duty of candor and good faith and accepting a statement made by Petitioner. See Changes to Patent Practice and Procedure, 62 Fed. Reg. at 53160 and 53178, 1203 Off. Gaz. Pat. Office at 88 and 103 (responses to comments 64 and 109)(applicant obligated under 37 C.F.R. §10.18 to inquire into the underlying facts and circumstances when providing statements to the Patent and Trademark Office).

³ See: Changes to Patent Practice and Procedure; Final Rule Notice, 62 Fed. Reg. at 53158-59 (October 10, 1997), 1203 Off. Gaz. Pat. Office at 86-87 (October 21, 1997).

⁴ The language of 35 U.S.C. §133 and 37 C.F.R. §1.137(a) is clear, unambiguous, and without qualification: the delay in tendering the reply to the outstanding Office action, as well as filing the first petition seeking revival, must have been unavoidable for the reply now to be accepted on petition. (Therefore, by example, an unavoidable delay in the payment of the Filing Fee might occur if a reply is shipped by the US Postal Service, but due to catastrophic accident, the delivery is not made.) Delays in responding properly raise the question whether delays are unavoidable. Where there is a question whether the delay was unavoidable, Petitioners must meet the burden of establishing that the delay was unavoidable within the meaning of 35 U.S.C. §133 and 37 C.F.R. §1.137(a) And the Petitioner must be diligent in attending to the matter. Failure to do so does not constitute the care required under Pratt, and so cannot satisfy the test for diligence and due care. (By contrast, unintentional delays are those that do not satisfy the very strict statutory and regulatory requirements of unavoidable delay, and also, by definition, are not intentional.))

Petitioner appears to have made the showing required.

As to Allegations of
Unintentional Delay

The requirements of a grantable petition pursuant to 37 C.F.R. §1.137(b) are the petition and fee therefor, a reply, a proper statement of unintentional delay under the regulation, and, where applicable, a terminal disclaimer and fee.

It appears that this matter now is moot.

CONCLUSION

Accordingly, the petition pursuant to 37 C.F.R. §1.181 is **granted** and the 1 June, 2010; the petition pursuant to 37 C.F.R. §1.137(b) is **dismissed as unnecessary**.

The instant application is released to the Technology Center 1600, AU 1656 for further processing in due course.

Petitioner may find it beneficial to view Private PAIR within a fortnight of the instant decision to ensure that the revival has been acknowledged by the TC/AU in response to this decision. It is noted that all inquiries with regard to that change in status need be directed to the TC/AU where that change of status must be effected—that does not occur in the Office of Petitions.

Telephone inquiries regarding this decision may be directed to the undersigned at (571) 272-3214—it is noted, however, that all practice before the Office is in writing (see: 37 C.F.R. §1.2⁵) and the proper authority for action on any matter in this regard are the statutes (35 U.S.C.), regulations (37 C.F.R.) and the commentary on policy (MPEP). Therefore, no telephone discussion may be controlling or considered authority for Petitioner's action(s).

/John J. Gillon, Jr./
John J. Gillon, Jr.
Senior Attorney
Office of Petitions

⁵ The regulations at 37 C.F.R. §1.2 provide:

§1.2 Business to be transacted in writing.

All business with the Patent and Trademark Office should be transacted in writing. The personal attendance of applicants or their attorneys or agents at the Patent and Trademark Office is unnecessary. The action of the Patent and Trademark Office will be based exclusively on the written record in the Office. No attention will be paid to any alleged oral promise, stipulation, or understanding in relation to which there is disagreement or doubt.